

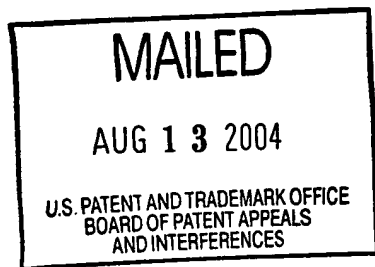
The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT A. CORDERY,
DAVID K. LEE, LEON A. PINTSOV,
FREDERICK W. RYAN, JR. and MONROE A. WEIANT, JR.



Appeal No. 2004-0492
Application 09/650,177

ON BRIEF

Before FRANKFORT, NASE and DIXON, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 35 and 36, the only claims remaining in this application. Claims 1 through 34 have been canceled.

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As noted on page 1 of the specification, appellants' invention relates generally to certification of users for electronic commerce, and more particularly, to a secure user certification system and method for electronic commerce that provides an accounting system for services provided. Independent claim 35, directed to a method for obtaining a cryptographic certificate, is representative of the subject matter on appeal and a copy of that claim can be found in Appendix A of appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Fischer '200	5,005,200	Apr. 2, 1991
Payne et al. (Payne)	5,715,314	Feb. 3, 1998

Claims 35 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fischer '200 in view of Payne.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejection, we refer to the examiner's answer (Paper No. 11, mailed June 3,

2003) and to appellants' brief (Paper No. 9, filed April 10, 2003) and reply brief (Paper No. 12, filed August 4, 2003) for a full exposition thereof.

OPINION

Having carefully reviewed the obviousness issues raised in this appeal in light of the record before us, we have come to the conclusion that the examiner's rejection of claims 35 and 36 under 35 U.S.C. § 103 will be sustained. Our reasoning in support of this determination follows.

In rejecting claims 35 and 36 under 35 U.S.C. § 103(a), the examiner has determined that Fischer '200 discloses a method for obtaining a cryptographic certificate including the steps of sending a certificate request to a certificate authority; receiving the certificate from the certificate authority, including a public key of a public/private key pair, and activating the private key (col. 3, lines 22-64; col. 6, lines 36-65; and col. 18, lines 33-68). What the examiner finds lacking in Fischer '200 is any disclosure or teaching concerning

a payment scheme for the certificate authority's services, and more specifically, no disclosure of a register having funds stored therein; determining if sufficient funds are present in the register for obtaining the certificate; and deducting funds from the register for obtaining the requested certificate, as are required in claim 35 on appeal. To account for these differences, the examiner looks to Payne, urging that Payne teaches a network sales system comprising a register having funds stored therein that allows a transaction between a buyer and a merchant to take place if the buyer's account has sufficient funds or credit (Fig. 1, step 76 of Fig. 2G, and col. 7, lines 5-30). The examiner then concludes that it would have been obvious to combine the systems of Fischer '200 and Payne, observing that by having an independent payment computer (e.g., a bank) verify a user's ability to pay prior to completing the transaction of a merchant, such as a certificate authority, can guarantee compensation for services rendered (answer, pages 4-5).

After a careful evaluation of the teachings and suggestions to be derived by one of ordinary skill in the art from the

Fischer '200 and Payne patents, it is our opinion that the examiner has met his burden of establishing a ***prima facie*** case of obviousness. More particularly, we agree with the examiner that one of ordinary skill in the art at the time of appellants' invention would have recognized that the certification service provided by the trusted third party or governmental agency as discussed in the public key/signature cryptosystem and digital signature certification E-commerce system of Fischer '200 (e.g., at col. 11, lines 52+) would have required payment for the services rendered therein, and further agree that it would have been obvious to such a person of ordinary skill in the art to utilize an electronic payment system and method like that broadly taught in Payne to ensure that the third party meta-certifier providing the services noted in Fischer '200 is fully and timely compensated for the services rendered.

Before we address appellants' arguments, we note that while it is true that the system and method as disclosed by appellants is intended to be implemented in a postage and certificate meter owned and controlled by a trusted third party certificate

authority such as the U.S. Postal Service, or some other form of value evidencing device, we find nothing in claims 35 and 36 on appeal which requires either a postage and certificate meter or other form of value evidencing device, or which sets forth any other limitation that so limits the method currently defined therein. Moreover, we are of the view that claims 35 and 36, as presently drafted, are not so limited as to specifically require all of the method steps to be performed in the exact order recited. With these understandings and interpretations in mind, we now proceed to appellants' arguments for patentability.

Appellants' first argument is that Payne merely teaches a conventional network based sales system that utilizes a credit card account to pay for purchases made on-line, and provides no disclosure, teaching or suggestion of any type of register with funds stored therein (brief, pages 8-9). Our review of the Payne patent reveals that the teachings and suggestions to be derived therefrom by one of ordinary skill in the art at the time of appellants' invention are somewhat broader than appellants seem to recognize. More specifically, we observe that while the Payne

patent broadly refers to a payment or payment transaction for the goods and/or services supplied therein and shows as one example thereof that such payment could be made by way of a credit card account (col. 6, lines 20-26), one of ordinary skill in this art reading the Payne patent would readily have understood from the disclosure of Payne that such payment may also be made in other ways where specific funds are available for payment, e.g., via a debit card account or an electronic check drawn on a checking account, both of which accounts would broadly have a register having funds stored therein available for payment for goods and/or services requested by the account owner or the owner's agent. Note particularly that Payne indicates that as part of the payment transaction, the payment computer receives payment account information from the user/buyer and then verifies whether the user account has "sufficient funds or credit" (col. 7, lines 14-15, emphasis added) to cover the required payment amount. Thus, contrary to appellants' argument, the system of Payne is not limited to payment only by a credit card account, but would have been recognized by those skilled in the art to also encompass payment from an account where specific funds would be stored in a register and then debited to pay for

goods and/or services obtained on-line, e.g., like the meta-certificate described in Fischer '200.

Appellants' next line of argument is that the examiner has not provided a baseline that determines the level of ordinary skill in the art (reply brief, pages 1-2) and that the examiner has relied upon the claims of the present application as a road map to seek out and combine selected pieces of prior art using impermissible hindsight to reconstruct the presently claimed invention. We do not agree. In the present case, we are of the view that the applied prior art references themselves reflect the high level of sophistication of the technology involved and evidence a high level of ordinary skill in the arts involved in Fischer '200 and Payne, where public key/signature cryptosystems, digital signature certification E-commerce systems and other forms of E-commerce purchase and payment systems and methods are described in complex art specific terminology. Moreover, based on our discussions above concerning the teachings and suggestions to be fairly derived from Fischer '200 and Payne by one of ordinary skill in the art, we find that the examiner has properly

factually supported a ***prima facie*** conclusion of obviousness, without hindsight reliance on appellants' disclosure, and correctly considered the evidence of record from the perspective of the hypothetical person of ordinary skill in the art when the invention was unknown and just before it was made.

Based on the foregoing, we will sustain the examiner's rejection of claim 35 on appeal under 35 U.S.C. § 103(a).

Appellants have also challenged the examiner's rejection of dependent claim 36 under 35 U.S.C. § 103(a), urging that the public and private keys of the key pair in Fischer '200 are active when they are generated, while appellants' claim 36 requires generating a first cryptographic key pair, and deducting funds from the register for obtaining the requested certificate "which activates a first private key of the first cryptographic key pair" (brief, page 13). Like the examiner, we are of the view that the broad language of appellants' claim 36 fails to link the activation of the private key of the cryptographic key pair to the deducting of funds from the register set forth in

claim 35. The literal language of claim 36 requires "generating a first cryptographic key pair, wherein said certificate request includes at least a first public key of the first cryptographic key pair, and activating a first private key of the first cryptographic key pair," and we see no reason why this is not accomplished in Fischer '200 where the public and private keys are generated and activated at the same time. In that regard, we again note that claims 35 and 36 on appeal are not so limited as to specifically require all of the method steps to be performed in the exact order recited. Thus, since appellants' argument is not commensurate in scope with the requirements of claim 36 on appeal, the examiner's rejection of claim 36 under 35 U.S.C. § 103(a) will be sustained.


Since we have determined that the examiner has established a ***prima facie*** case of obviousness with regard to the claimed subject matter before us on appeal, the decision of the examiner to reject claims 35 and 36 under 35 U.S.C. § 103(a) is affirmed.

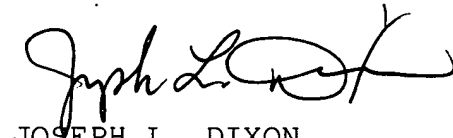
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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED


CHARLES E. FRANKFORT
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge


JOSEPH L. DIXON
Administrative Patent Judge

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